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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,317	05/28/2002	Mikkel Selder	003300-927	7288

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EXAMINER

BEISNER, WILLIAM H

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/089,317	Applicant(s) SELDER, MIKKEL	
	Examiner William H. Beisner	Art Unit 1744	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-9 and 11-19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

  
William H. Beisner  
Primary Examiner  
Art Unit: 1744

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 1, 10 and 20 under 35 USC 112, second paragraph, and the rejection of claims 10 and 20 under 35 USC 102(b).

Continuation of 11. does NOT place the application in condition for allowance because: With respect to the rejection of claims 1-5, 9-15, 18 and 19 under 35 USC 103 over the combination of Applicant's admission of prior art with Boulton and Nelson, Applicant argues (See pages 7-8 of the response filed 1/18/06) that the rejection is "lacking a sound technical and legal bases". To support this argument, Applicant stresses that the "hot and cold" process of the prior art does not disclose or suggest the instantly claimed process. Applicant stresses that pointing to the references of Boulton and Nelson to indicate that their processes could have also been performed in the same vessel or tank does not resolve the issues of patentability. Applicant points out that while the reference of Nelson suggests several ways of arranging the change from hot to cold, he never describes or suggests the importance of simultaneous discharge and supply as claimed by Applicant. Applicant argues that the reference of Boulton is silent with respect to the limitations of step (d) of instant claim 1. Throughout the arguments, Applicant stresses that the instant invention provides advantageous impregnation results that support the nonobviousness of the instant claims. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Examiner is of the position that the combination of the references that suggests the claimed invention. The Examiner does not rely on a single reference to disclose or suggests the totality of the limitations recited in independent claim 1. With respect to the disclosure of the reference of Boulton, this reference was not relied upon to address the limitations of step (d) but rather to address the use of a vacuum recited in step (c). With respect to the disclosure of the reference of Nelson, the Examiner is of the position that the totality of the disclosure of the reference of Nelson would have suggested the simultaneous discharge/supply required of step (d) in view of the disclosure that an improved process results from wood that has been treated in a hot bath is "immediately immersed" in a second bath (See page 1, lines 32-56). This disclosure suggests that the wood can be moved between two different tanks or vessels or can be treated within the same tank or vessel. The disclosure even recites drawing off the hot liquid and replacing it with a cold liquid (See page 2, lines 47-63). Clearly one of ordinary skill in the art would recognize that "simultaneous discharge/supply" of the hot and cold liquids would provide the "immediately immersed" required of the reference of Nelson and would be equivalent to removing the wood from a hot bath and "immediately" immersing it in a second cold bath. Completely draining the hot liquid followed by filling with a cold liquid would not provide the "immediately immersed" required of the disclosure of Nelson. With respect to Applicant's comments that the instant process is advantageous and/or improved over the methods of the prior art, the reference of Nelson discloses that the "immediately immersed" process provided an improved process that results in deeper penetration of the wood (See page 1, lines 32-35). Note while Applicant's examples on pages 4-6 of the instant specification disclose that the wood treated resulted in the uptake of oil, it is not clear how "advantageous impregnation results" were achieved in the absence of any comparison with the prior art methods. Furthermore, if Applicant is taking the position that the instant method provides "unexpected" results, the Examiner would like to point out that the instant claim 1 is not even commensurate in scope with the Examples and Applicants comments which imply that the overpressure contributes to the "improved" or unexpected results. Claim 1 merely recites "preferably" providing an overpressure. With respect to the rejection of claims 6-8, 16 and 17 under 35 USC 103 over the combination of Applicant's admission of prior art with Boulton and Nelson taken further in view of Kraft Foods, Applicant argues (See page 9 of the response filed 1/18/05) that the reference of Kraft Foods does not make up for the deficiencies of the combination of references previously discussed above. In response, the reference of Kraft Foods was relied upon to address the additional claim limitations of claims 6-8, 16 and 17 and not claim 1. The Examiner is of the position that the combination of Applicant's admission of prior art with Boulton and Nelson meets the limitations of claim 1 for reasons already of record. With respect to the rejection of claims 1-5, 9-15, 18 and 19 under 35 USC 103 over the combination of the references of Nelson in view of either Gillet or Hungbau KFT in view of Boulton, Applicant argues (See page 9 of the response filed 1/18/05) that the rejection is improper for the same reasons with respect to the combination of Applicant's admission of prior art with Boulton and Nelson. In response, the Examiner maintains that the rejection is proper for the same reasons as set forth above. With respect to the rejection of claims 6-8, 16 and 17 under 35 USC 103 over the combination Nelson in view of either Gillet or Hungbau KFT in view of Boulton taken further in view of Kraft Foods, Applicant argues (See page 10 of the response filed 1/18/05) that the reference of Kraft Foods does not make up for the deficiencies of the combination of references previously discussed above. In response, the reference of Kraft Foods was relied upon to address the additional claim limitations of claims 6-8, 16 and 17 and not claim 1. The Examiner is of the position that the combination of Nelson in view of either Gillet or Hungbau KFT in view of Boulton meets the limitations of claim 1 for reasons already of record.